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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/925,696	08/09/2001	Ing Vojtech Benetka	PH44	4284
26841	7590	05/17/2005	EXAMINER	
MARK P. BOURGEOIS P.O. BOX 95 OSCEOLA, IN 46561			GRUNBERG, ANNE MARIE	
			ART UNIT	PAPER NUMBER
			1661	

DATE MAILED: 05/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/925,696

Applicant(s)

BENETKA ET AL

Examiner

Anne Marie Grunberg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The text of those sections of Title 35 U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102

1. Claim 1 remains rejected under 35 U.S.C. 102(b), for the reasons stated below.

Applicants argue that the combination of a non-enabling printed publication with foreign commercial use is not a bar to patentability under 35 U.S.C. 102(b) for plant patents because every element of a new plant variety can not be disclosed in a printed publication as required in *LeGrice* and because it is improper to combine a non-enabled reference with sale.

Applicant further argues that foreign public or commercial activity fails as a barring activity.

Finally, Applicant argues that the purchasing public would not have been aware of the claimed plant because it was not identified as 'Pink Poppet'. Applicant argues that the breeder would not know that Piccolo is the same plant as Plangen and the breeder would not know that Piccolo is the same plant as Pink Poppet.

These arguments have been carefully considered but are not persuasive. As to the second point, the rejection is made over a publication in this or a foreign country. As to the first point, *In re Elsner* indicated that under certain circumstances a printed publication may be a 102(b) bar to a plant patent, when the publication is shown to be enabling. Specifically, "[w]hen a publication identifies the plant that is invented or

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discovered and a foreign sale occurs that puts one of ordinary skill in the art in possession of the plant itself, which, based on the level of ordinary skill in the art, permits asexual reproduction without undue experimentation, that combination of facts and events so directly conveys the essential knowledge of the invention that the sale combines with the publication to erect a statutory bar.” 381 F.2d at 1129. These requirements may be met if (1) the foreign sale must not be an obscure, solitary occurrence that would go unnoticed by those skilled in the art, and (2) one of ordinary skill would have been able to asexually reproduce the plant.

It is not clear if the facts of this case establish that the sale here was not an obscure, solitary occurrence. Applicants admit that the claimed plant was sold more than one year prior to the effective filing date. It appears that one of ordinary skill in the art would have been able to obtain the plant. Applicant does not argue that the sale was an isolated event so it is presumed that this plant was publicly available.

However, this case is different from *Elsner* in the sense that a name change has occurred. The primary question at issue here is, “Does a name change create a situation where 35 USC 102 no longer applies?” Plants are commonly marketed using a different name than that found in a patent. Trade names are commonly given to plants once they are sold, or plants are sometimes marketed as a group and given a group name. Just because the name is changed does not affect the fact that the plant was publicly available. One of ordinary skill in the art still would have been able to obtain the plant and reproduce it as well. A person of ordinary skill in the art at the time the invention was made would have known to contact the breeder, whose contact

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information is listed on the Plant Breeders' Right publication, and ascertain that the plant was being sold under a particular name as well as from where to buy or otherwise obtain the plant. It is deemed that a name change does not in any way limit the plant from being obtained and reproduced and as such, the rejection under 35 USC 102(b) would still apply. It is unclear how the breeder would not know the name of the plant that they were producing and selling, but it does not change the fact that the plant was available to the public and thus enabling the publication.

The second requirement that In re Elsner makes is that one of ordinary skill in the art must be able to reproduce the invention. Propagation of weigela is well known in the art. Examples of how to propagate weigela are given in the RHS at page 702, last paragraph and the top of page 703, first paragraph. As a result, it is concluded that one of ordinary skill in the art would have been able to reproduce the invention.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne Marie Grunberg whose telephone number is 571-272-0975. The examiner can normally be reached on Monday - Friday 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on 571-272-0811. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


ANNE MARIE GRUNBERG
PRIMARY EXAMINER